

REMARKS

Claims 1-20 are pending in this application. Claims 1-16, 19, and 20 stand rejected and claim 18 is objected to. Applicant wishes to thank the Examiner for the indication of allowance of claim 17, and the indication of allowable subject matter in claim 18. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1-2, 5-8, and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,269,260 ("Shin"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir. 1991).

Independent claim 1 explicitly recites a method of calling a function by key word detection. In particular, a function is associated with a particular key word. The portable communication terminal apparatus receives character data. When the key word is extracted from the received character data, the function associated with the key word is called and executed.

For example, when a registered key word in a key word table is extracted from a received Email message, the terminal apparatus performs a function associated with that key word. For example, the terminal apparatus will play a melody, sound

effect, voice function, display light, blinking function, vibration motor control or the like. This is not present in Shin.

In the Examiner's response to Applicant's arguments, the Examiner states that "when the user enters a specific character string, the key word is extracted from the display screen, the word is received and extracted from the key word memory table of the mobile apparatus and a function is called when the control unit of the mobile apparatus recognizes the key word as one of the key words in the memory." See Office Action at 2. (emphasis added) Applicant agrees with the Examiner's assertion. However, Applicant's invention is different than what the Examiner asserts that Shin discloses. In Shin, a user registers a character string for later use. The user will then manually enter the character string thereby calling the function previously associated with that character string.

In contrast, according to Applicant's explicitly recited claim, the function associated with a key word is called when the key word is extracted from received character data, not input character data. Applicant has drafted his claims carefully to reflect that the key word is extracted from received character data not input character data as is taught by Shin. Therefore, Applicant respectfully submits that Shin fails to disclose receiving character data within the scope of Applicant's claims. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 1 and dependent claims 2, 5-8, and 20.

Claims 9-12 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shin in view of U.S. Patent No. 6,445,932 ("Soini"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

As discussed above, Shin does not disclose extracting the key word from received character data as explicitly recited in Applicant's claims. In Shin, character data is input into the device and a related function is thereby called. However, this is not the same thing. Applicant relies on calling a function based on received character data, i.e., no inputting action by the user whereas in Shin, the function is called based on data input by the user. Thus, Shin fails to disclose the extracting of the key word from received character data as explicitly recited in the claim. Soini was not included to cure this deficiency but to show additional limitations which, even if it were to show, do not cure the deficiencies in Shin discussed above. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No.: 09/851,303

Docket No.: S1905.0101

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: September 22, 2005

Respectfully submitted,

By 

Ian R. Brun

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN & OSHINSKY
LLP

1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

IRB/mgs